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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,974	03/11/2004	Takashi Kobayashi	Q79726	4051
23373 7590 06/26/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER SMITH, FRANCIS P	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 06/26/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/796,974

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

Francis P. Smith

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 6/18/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on April 25, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,777,039 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

2. Applicant's arguments, see page 3, first paragraph, filed April 7, 2008, with respect to the rejection(s) of claim(s) 1 and 2 under 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in light of Kobayashi et al (JP 11-192777) in view of Sismondi et al. (US 6,764,727).

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (JP 11-192777) in view of Sismondi et al. (US 6,764,727).

Regarding claims 1 and 2, Kobayashi teaches a recording sheet which records a picture using a color material. Specifically, a coating liquid is prepared that contains inorganic silica particles and polyvinyl alcohol, whereby the coating liquid is applied to the surface of a support using a coater ([0016], [0017], [0040]). Before a falling-drying –

rate period of drying of the coated layer, a solution is applied (e.g. preparing/applying a solution) containing a crosslinking agent (e.g. boron) and a mordant ([0016]-[0017]). The coating layer is then cured ([0045]). Kobayashi, however, does not explicitly disclose utilizing at least one compound represented by formulas (1) and (2).

Sismondi teaches an inkjet receiving sheet that features an ink receiving layer comprising a high boiling organic solvent. Specifically, Sismondi teaches utilizing diethylene glycol monobutyl ether (e.g. compound (1) of the instant application) as a high boiling organic solvent in the ink receiving layer. Therefore, one having ordinary skill in the art at the time of the invention would have utilized Sismondi's high boiling point organic solvent which is liquid at room temperature in Kobayashi's method in order to effectively deposit a water soluble polyvinyl alcohol resin and inorganic silica particles where the solvent may be subsequently removed by heating.

As per claim 2 regarding the changing in sequence of adding parts, selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. *Consult In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) and Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959).*

Furthermore, it is noted that claims 1 (lines 3-4) and 2 (lines 13-14) contain product by process language ("vapor-phase process silica). If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).*

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Francis P. Smith whose telephone number is (571) 270-3717. The examiner can normally be reached on Monday through Thursday 7:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mikhail Kornakov can be reached on (571) 272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FPS

/Michael Kornakov/

Supervisory Patent Examiner, Art Unit 1792